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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,624	07/24/2003	Elizabeth A. Colbert	1034296-000018	8076

21839 7590 07/28/2008  
BUCHANAN, INGERSOLL & ROONEY PC  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER
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RUDDOCK, ULA CORINNA

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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07/28/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

## Office Action Summary

**Application No.**

10/625,624

**Applicant(s)**

COLBERT, ELIZABETH A.

**Examiner**

Ula C. Ruddock

**Art Unit**

1794

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 32-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Examiner has carefully considered Applicant's amendment and accompanying remarks filed April 10, 2008. The 112, 1st paragraph rejection has been withdrawn. After an updated search, additional prior art has been found which renders the invention as currently claimed unpatentable for reasons herein.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

3. Claims 1-19 and 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francis et al. (US 4,287,103) in view of Zuber et al. (US 6,105,325). Francis et al. disclose wallboard comprising a gypsum core sandwiched between paper facings (col 1, ln 9-10), wherein the paper facing is coated with a joint composition (col 1, ln 17-26). The joint composition comprises filler material, adhesive binder, and water. As seen in Table 1, water is present in the composition in the amount of 33.5-35.5% by weight. The preferred filler is gypsum or limestone (i.e. calcium carbonate) (col 5, ln 19-25) in the amount of 25-93% by weight (col 5, ln 21). Mica or talc are also added to the composition (col 4, ln 42) in the amount of 5-50%. The binder, which is latex (see col 2, ln 60), is present in the amount of 2-12% by weight. It should be noted that in claim 6 of the present invention, filler (0-30%) and additives (0-10%) are being treated as optional components since they can be present in the composition in the amount of 0%. Also, in claim 9, limestone (0-50%), clay (0-10%), other fillers (0-30%), and additives (0-10%) are being treated as optional components since they can be present in the composition in the amount of 0%. Francis et

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al. disclose the claimed invention except for the specific teaching that the gypsum board is precoated with a coating during manufacture. Francis et al. also fail to teach that the coating penetrates through at least a portion of the facing sheet and into the gypsum core. Finally, Francis et al. fail to disclose that the composition comprises a pigment material and that the paper is an unbleached grey paper.

Zuber et al. (US 6,105,325) disclose a plasterboard material comprising a plaster body and at least one sheet of lining paper (i.e. facing) comprising a mineral filler of light color (abstract). The pigment layer comprises a white mineral filler (col 3, ln 60-63). In addition, one of the sheets of paper can be unbleached grey paper (col 3, ln 25-28). Zuber et al. also disclose assembling a plasterboard with at least a joint coat (claim 1) which can be equated to Applicant's limitation that the gypsum board is precoated during manufacture. It would have been obvious to one having ordinary skill in the art to have used Zuber's method of precoating the gypsum board during manufacture on the wallboard of Francis, motivated by the desire to create a wallboard with cheaper processing costs and to create a wallboard that is relatively uniform.

It would have been obvious to one having ordinary skill in the art to have used the pigment of Zuber in the composition of Francis, motivated by the desire to create a joint composition that has the desired tint. It also would have been obvious to one having ordinary skill in the art to have made the paper of Francis be the unbleached grey paper of Zuber, motivated by the desire to create a wallboard material that has cheaper manufacturing costs, due to not bleaching the paper.

It also would have been obvious to one having ordinary skill in the art to have the joint composition of Francis and Zuber penetrate through the paper and into the gypsum core,

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motivated by the desire to create a wallboard material that has increased lamination strength and tear resistance. Because the same materials are being used as the facing sheet (paper) and coating (joint compound), the coating would penetrate therethrough.

Regarding claims 3 and 4, Francis et al. and Zuber et al. do not disclose the specific coating thickness. However, in the absence of unexpected results it would have been obvious to one having ordinary skill in the art to have made the thickness of the coating up to 30 mils or preferably 3-20 mils, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. In the present invention, one would have optimized the coating thickness motivated by the desire to create a wallboard material that has decreased delamination and increased strength.

Regarding claims 12, 13, 15, 18, although Francis and Zuber do not explicitly teach the claimed level 4 or level 5 finish, it is reasonable to presume that this property is inherent to the invention of Francis and Zuber. Support for said presumption is found in the use of like materials (i.e. gypsum board, paper facing, and a coating comprising water, gypsum or limestone, latex binder, clay or mica or talc, and other additives) and the use of like processes (i.e. coating the gypsum board during manufacture). The burden is upon Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In addition, the presently claimed property of a facing sheet with a level 4 or level 5 finish, would obviously have been present once the Francis and Zuber product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

Regarding claims 32-39, it should be noted that the method of forming an article is not germane to the issue of patentability of the device itself. Furthermore, it would have been obvious to one having ordinary skill in the art to have applied the precoating either before or after the board is passed through a drying oven, motivated by the desire to obtain a wallboard that has a uniform appearance.

4. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/U. C. R./

/Ula C Ruddock/  
Primary Examiner, Art Unit 1794